

Remarks

Reconsideration and allowance in view of the comments which follow are respectfully requested.

Claims 1-23 remain pending in this application. No claim amendments are being presently proposed. The listing of claims shows all of the amendments relative to the claims made from the original issued patent.

In the Office Action dated April 17, 2008, the Examiner rejected claims 1-23 as being allegedly obvious over Montana Burst in Gram Faceting Designs (“GFD” or “Montana Burst”) in view of Grossbard U.S. Patent No. 4,020,649 (“Grossbard ‘649” or Grossbard”). The Examiner stated that the Supplemental Declaration of Detra Segar (“Segar Supp Dec”) was found to be insufficient to overcome the obviousness rejections. The Examiner said that the Segar Supp Dec: (1) failed to show that the claimed gemstone is the reason for success of the jewelry line; (2) failed to state that jewelry line is the claimed gemstone; and (3) failed to state the type of gemstones sold, the amount and marketing budget compared to other lines.

Applicant respectfully traverses the rejection based on obviousness for the reasons stated in the previous filing on November 5, 2007 and based on the factual evidence submitted by the Declarations. Applicant believes that the Examiner may not have considered the Second Supplemental Declaration of Robert S. Greeff and the Declaration of Jane Lucyk which addresses the very points which the Examiner said were not addressed in the Supplemental Declaration of Detra Segar.

The Supplemental Declaration of Robert S. Greeff (“Greeff Supp Dec”) submitted on or about October 31, 2007 states in ¶23:

23. Since 1999, Tiffany has been selling a jewelry line under the trademark LUCIDA having gemstones which have the features shown in the drawings, and described by the claims, of the above referenced U.S. Patent No. 6,363,745 and the present reissue application. Upon information and belief, the LUCIDA jewelry line has enjoyed significant commercial success, while at the same time not causing any significant detrimental effect on Tiffany’s other jewelry lines having other gemstone cuts such as round brilliant. Upon information and belief, the commercial success of the LUCIDA line has been due to the unique gemstone cut of a step crown and brilliant pavilion according to the presently pending claims of the reissue application. Upon information and belief, over 90% of the gross sales of the LUCIDA line is for diamond gemstones, with a much smaller (less than 10%) based on gemstones which are not diamond.

This paragraph establishes that:

1. The Lucida jewelry line uses gemstones according to the subject claims;
2. The Lucida line has enjoyed commercial success, while not causing any significant detrimental effect on Tiffany’s other jewelry lines;
3. The commercial success of the Lucida jewelry line is due to the claimed features;
4. Over 90% of sales of the Lucida line have been for diamond gemstones.

The Declaration of Jane Lucyk (“Lucyk Dec”) submitted on or about October 31, 2007 recited the specific sales records of the Lucida jewelry line annually from 1999 until 2006, totaling \$233.6M over this time period. For clarification, the sales in the Lucyk Dec were for U.S. only, and were for sales of all jewelry products, including watches containing the Lucida gemstone.

The Supplemental Declaration of Detra Segar (“Segar Supp Dec”) submitted on or about March 10, 2008 stated:

7. The marketing and advertising effort and expense for the LUCIDA gemstone line has not substantially exceeded the marketing and advertising effort and expense (on a percentage of sales basis) for other gemstone lines.

Applicant believes that the evidence already of record establishes that the invention defined by the present claims has been commercially successful, which success should be sufficient to establish non-obviousness of the invention.

Without conceding the correctness of the Examiner’s position, but solely to advance prosecution, applicant submits: 1. Declaration of Jin Song (“Song Dec”); 2. Declaration of Clair Mah (“Mah Dec”) and 3. Second Supplemental Declaration of Robert S. Greeff (“Greeff Second Supp Dec”) which address the points which the Examiner alleged that the commercial success Declarations were insufficient.

The Song Dec establishes that the Lucida gemstone sold as a Solitaire Diamond Ring (“SDR”) has been commercially successful, and that the commercial success of the Lucida gemstone has not come at the expense of reducing sales of its Tiffany Setting engagement gemstone line, which is its mainstay round brilliant gemstone. The Mah Dec reports on advertising and marketing expenses of the subject Lucida gemstone in SDRs, as well as like expenses for the Tiffany setting and Legacy SDR lines. Taken together with the sales figures from the Song Dec, the Song and Mah Decs establish:

1. For Tiffany Setting SDRs for the period 2001-2007 inclusive, advertising and marketing expenses worldwide as a percentage of sales worldwide was about 1.9 % (\$21,398K/1,111M).
2. For Lucida SDRs for the period 2001-2007 inclusive, advertising and marketing expenses worldwide as a percentage of sales worldwide was about 3.1% (9,434K / \$299.5M)
3. For Legacy SDRs for the period 2001-2007 inclusive, advertising and marketing expenses worldwide as a percentage of sales worldwide was about 8.0% (\$5,239K (\$3,715K / \$65.4M)

The advertising and marketing expenses for the Lucida SDR were only 3.1% of sales over the sales period 2001-2007, well below the advertising and marketing expenses of about 8.0% of sales for Legacy over its sales period of 2003-2007. For purposes of comparison, Tiffany Setting SDRs advertising and marketing expenses as a percentage of sales were about 1.9 %. While Tiffany Setting has the lowest expense/sales percentage (due to its well established place in the Tiffany line), the Lucida expense/sales percentage is only slightly greater. Clearly, the commercial success of the Lucida gemstone has not been due to any abnormal promotional activity compared to Tiffany Setting, and especially Legacy.

The Greeff Second Suppl Dec being submitted herewith adds new ¶24 which states:

24. The Lucida jewelry line contains essentially only gemstones which are described by the subject claims, so that virtually all of the value of the Lucida jewelry line is attributable to the Lucida gemstones covered by the subject claims.

Applicant urges that the totality of the factual evidence submitted by way of the Declarations clearly establishes that the gemstone covered by the subject claims has been commercially successful.

Another objective inducia of patentability supporting non-obviousness of the claimed subject matter is copying of the claimed invention. Applicant submits as Exhibit A website pages describing a gemstone marketed by Cut by Gauge® under the mark Lucére®. Page 2 of 3 of the www.voyagerjewelrydesign.com website shows the crown and pavilion of this gemstone. This Lucére gemstone is believed to incorporate the features of at least pending claims 1-5, 8, 9, 11, 15, 16 and 21. Generally, the Lucére gemstone has a stepped crown with longer sides and shorter corners, and a pavilion having four sides and four corners defined by eight distinct rib lines extending from the girdle to the culet in substantially straight lines, as well as the other features recited in the listed claims.

Of significance is that Slotar's selection of the mark "Lucére" shares the same first three letters of the applicants mark "Lucida", which applicant believes is strong evidence that Slotar wishes to communicate to the purchasing public that the Lucere gemstone is essentially the same design as applicants' Lucida gemstone.

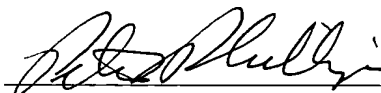
In view of the foregoing, applicant believes that the application is in condition for allowance, and such action is earnestly solicited.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

Tiffany & Company
Reissue Application No.: 10/626,376
Reissue of Patent No.: 6,363,745
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Applicant submits a three-month extension fee of \$810 and the RCE fee of \$1,110 totaling \$1,920. No other fee is deemed necessary in connection with the filing of this Response. However, if any additional fee is required, or if the amount submitted is insufficient, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

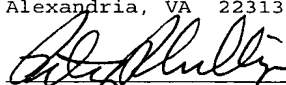
Respectfully submitted,



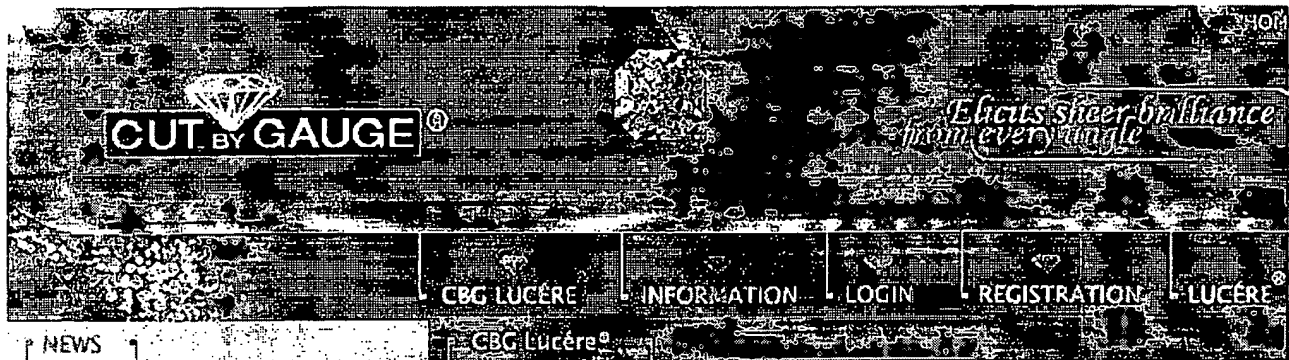
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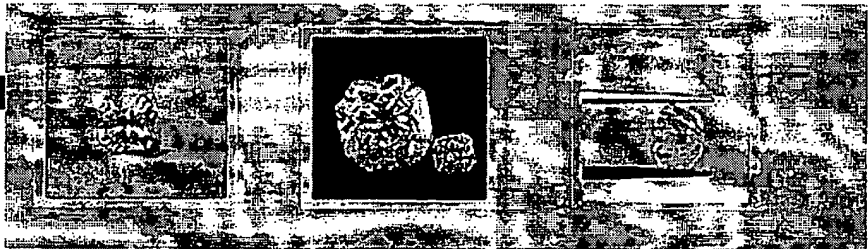


- Specializing in Ideal Cuts with Hearts and Arrows.
- The Lucère™ Diamond.
- Large Fancy Shaped Diamonds and Fine Finished Jewelry.
- AGS, GIA, and HRD Certificates.

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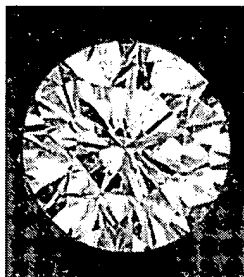
The Cut by Gauge® Lucère® is a mixed cut square diamond. The AGS classify the Lucère® as a "Cut Cornered" diamond. The Lucère® exhibits a three tiered structure upon a modified round brilliant Pavilion. This allows it to display the distinctly classic straight lines of a square without losing the essence of the diamond - it's the corners of the Lucère® to define its unique shape and easy to set and to lend it's cut cornered shape a variety of mounting than traditional square diamonds. Most importantly we standardize the proportions to ensure consistency in make and Brilliance. The Lucère® is unrivaled in its make and unparalleled in its beauty as a square diamond. It is the perfect elegant blend of square and round faceting.



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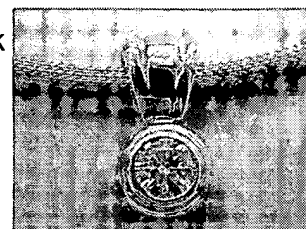


Click here to go directly to information on the
Cut By Gauge® Lucére® Diamond



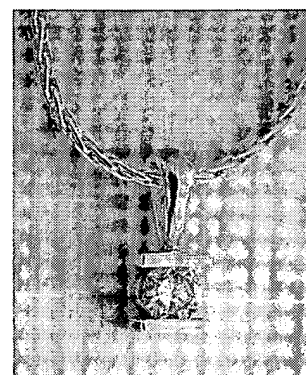
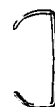
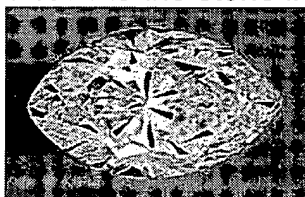
THE 4 C's.....

Like two fingerprints, two Diamonds that look alike at first may, in fact, be very different. Two Diamonds of equal size can have very unequal values. To understand these differences is to understand the 4 C's: Cut, Color, Clarity, and Carat-weight.



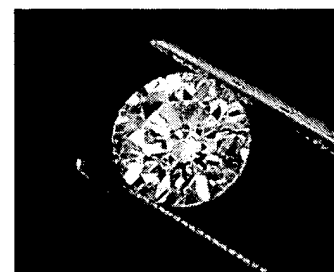
At The Voyagers, our experienced staff will be happy to educate you on the 4C's and answer any questions you may have.

THE FIRST C ~ CUT....we will show how proportions effect the brilliance of a Diamond. The cut of a Diamond effects more than just its shape. Ideal Cut Diamonds have strict guidelines for the way each facet is cut into the stone in order to produce the most brilliance.

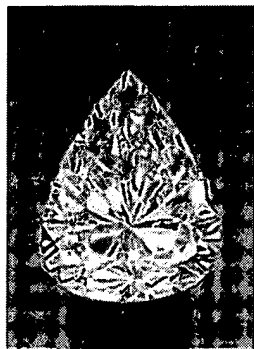


THE SECOND C ~ CLARITY....using the microscope, we will explain the identifying characteristics (fingerprints) of the Diamonds; also known as inclusions. There are eleven clarity grades that are used to judge Diamonds. All of the grades are judged under a microscope at ten power. We also stock certified G.I.A. diamonds. Click here for information about the [Gemological Institute of America](#) -- where the standards for the jewelry industry are set.

THE THIRD C ~ COLOR....we will even show you the Diamond's color with several comparison Diamonds. Diamonds are available in almost every color of the rainbow; and when that color is intense, the value of the Diamond grows. However, when a Diamond has a hint of color, such as brown or yellow, that detracts from value of the Diamond.



THE FOURTH C ~ CARAT weight....The Voyagers carries a wide range Diamond sizes to help you best select the carat weight for your needs. A good reminder for carat weight is bigger is not always better.

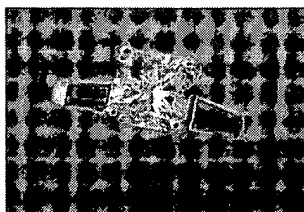
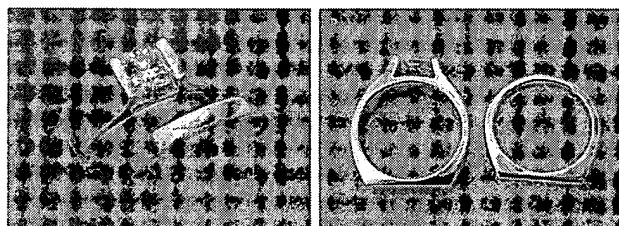
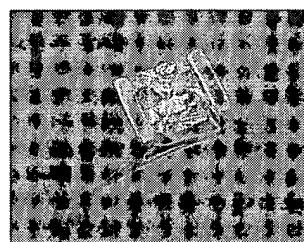
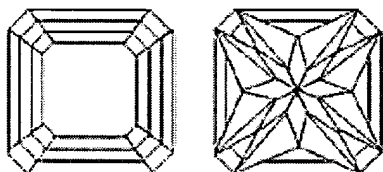


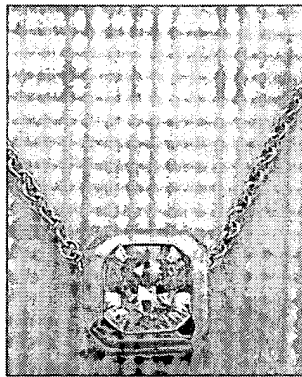
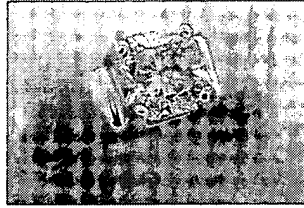
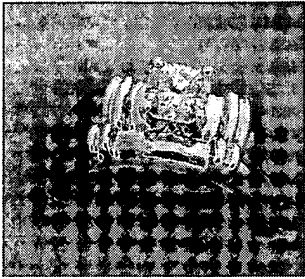
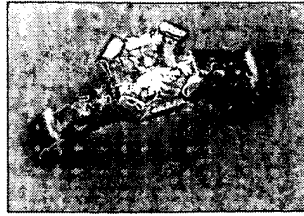
Let the Voyagers

be your guide to selecting the quality Diamond that best suits your needs; because like fingerprints, no two Diamonds are the same.



Cut By Gauge® Lucére® Diamond is a mixed-cut stone combining the crown of an emerald cut with a pavilion similar to that of a round. The table and depth percentages are standardized to ensure consistency which results in very brilliant stones. It is a perfect blend of the brilliance of a round diamond yet in a square shape; a Cut By Gauge® Lucére® Diamond is uniquely proportioned for maximum Brilliance and Beauty.





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